

**REMARKS****I. STATUS OF THE PENDING CLAIMS**

Claims 11-23, 25-31, 33, 34 and 36-39 are pending in this application. Claims 12 and 26 are cancelled herein.

Claim 13 is objected to allegedly because of an informality in the claim element “the control.”

Claims 25-30 are rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. Claims 11-23, 25-31, 33, 34 and 36-39 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,900,259<sup>1</sup> to Miyoshi (“Miyoshi”). Claims 14, 15 and 22 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Miyoshi in view of Official Notice.

Claims 11, 13, 14, 25, 27 and 38 are amended herein. Support for these amendments can be found throughout the application as originally filed, for example, paragraphs 11 and 22 of the specification. Applicants respectfully submit that no new matter is introduced.

**II. CLAIM OBJECTION**

The Office Action objects to claim 13 because of an alleged informality. The Office Action states that the claim element “the control” as recited in line 2 should be amended to “the control unit.” Applicants have amended claim 13 to more particularly point out “the control

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<sup>1</sup> The Office Action refers to U.S. Patent No. 5,411,686 (“the ‘686 patent”) as the Miyoshi reference. (Office Action, page 3). However, the ‘686 patent was previously relied on by the USPTO as a basis for rejection and would not constitute a new ground of rejection. Applicants note that the Examiner cited U.S. Patent No. 5,900,259 (“the ‘259 patent”) as the Miyoshi reference in the PTO-892, Notice of Reference Cited, that accompanied the non-final office action of April 28, 2008. It appears that the Examiner may have intended to cite the ‘259 patent, instead of the ‘686 patent. In the interest of expediting the prosecution of the present application, Applicants have addressed the rejections raised by the non-final office action of April 28, 2008 in view of the ‘259 patent.

process" in line 2. In view of this amendment, Applicants respectfully request withdrawal of this claim objection.

### **III. REJECTIONS UNDER 35 U.S.C. §101**

Claims 25-30 are rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. The only reason provided by the Office Action for the rejection under §101 is that "[t]he claims are directed to software which is nonstatutory." (Office Action, 2). Applicants respectfully traverse this rejection.

The rejection of claims 25-30 as directed to non-statutory subject matter under 35 U.S.C. 101 is made without support of any authority whatsoever and is clearly improper. According to Federal Circuit case law, inventions relating to software is not *per se* non-statutory subject matter. Rather, the Federal Circuit in *AT&T v. Excel Communications*, 172 F.3d 1352, 1360 (Fed. Cir. 1999) stated that "it is now clear that computer-based programming constitutes patentable subject matter so long as the basic requirements of §101 are met." Furthermore, as set forth in *In re Beauregard*, "computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. §§ 102 and 103." *In re Beaurgard*, 53 F.3d 1583, 1584 (Fed. Cir. 1995).

Moreover, the Office Action's unsupported conclusion is not provided for by any law or rule and contradicts USPTO guidelines. MPEP §2106.01 clearly sets forth that "when **functional descriptive material** is recorded on some **computer-readable medium**, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." Applicants respectfully submit that while the USPTO's narrow interpretation of 35 U.S.C. §101 is not commensurate with the broad scope of patentable subject matter allowed by the applicable case

law, the presently pending claims 25-30 nonetheless do meet the USPTO's narrow requirements. Specifically, the claims 25-30 are directed to a computer for controlling and monitoring an injection-molding machine. The computer is a structural medium for performing the recited functions.

As required by MPEP §2107.02,

To properly reject a claimed invention under 35 U.S.C. §101, the Office must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing... The *prima facie* showing must be set forth in a well-reasoned statement. Any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility.

The Office Action has not begun to meet the requirements for a rejection under 35 U.S.C. §101. The Office Action provides only a conclusory statement, without setting forth any legal or factual bases, that “[t]he claims are directed to software which is nonstatutory.” As instructed by the MPEP §2107.02, “[i]f the Office cannot develop a proper *prima facie* case and provide evidentiary support for a rejection under 35 U.S.C. 101, a rejection on this ground should not be imposed.” (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.... If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.”)).

**IV. REJECTIONS UNDER 35 U.S.C. §102(b)**

Claims 11-23, 25-31, 33, 34 and 36-39 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,900,259 to Miyoshi (“Miyoshi”).

A rejection of claims as anticipated under 35 U.S.C. §102(b) requires a showing that each and every claim limitation be identically disclosed in the applied reference. If even one claim limitation is not disclosed in the reference, the claim is patentable over the reference.

Applicants’ independent claim 11, as amended, recites “receiving at the computer at least one input from an operator and sending the received at least one input to the control process virtually in parallel with the execution of the monitoring process. Independent claims 25 and 38 have been amended to include similar claim elements. Additionally, Applicants’ independent claim 18 recites “wherein the computer evaluates and monitors the received actual values associated with the injection-molding process virtually in parallel with receiving at least one input from the operator....” Similarly, independent claim 31 recites “receiving at the control unit virtually in parallel to executing the monitoring procedure at least one input from an operator.”

Miyoshi does not teach or suggest sending the at least one input, received at the computer from an operator, to the control process virtually in parallel with the execution of the monitoring process. The Office Action relies on col. 12, lines 40-48 of Miyoshi for this claim element, which states that “[i]n the system shown in FIGS. 1 and 2, the operator can input the mold design data to the clamp-side condition determining section B-2 by operating input means (not shown).” (See Office Action, 4). Miyoshi makes no mention of sending a received input to the control process virtually in parallel with the execution of the monitoring process. Rather, as described by Miyoshi, the “mold design data” referred by the cited portion of the reference must be inputted before initiating the molding process. The “mold design data” is defined by Miyoshi as “a group of information such as the mold height, and the information of whether angular pin is

provided or not, and the maximum ejector stroke.” (Miyoshi, col. 8, lines 8-10). These types of information are design parameters for the mold, which by definition, must be established before initiating any injection-molding process. Therefore, these design parameters must necessarily be transmitted before the execution of any monitoring process for an injection-molding process and cannot be transmitted virtually in parallel with the execution of a monitoring process.

Therefore, Applicants respectfully request that the §102(b) rejections of claims 11-23, 25-31, 33, 34 and 36-39 be withdrawn.

#### V. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 14, 15 and 22 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Miyoshi in view of Official Notice. Applicants respectfully traverse this rejection.

A rejection under 35 U.S.C. §103(a) requires the establishment of a *prima facie* case that the claimed subject matter, including all claim elements, would have been obvious to a person having ordinary skill in the art on the basis of either a single prior art reference or more than one reference properly combined. As no such *prima facie* case has been established for these claims, Applicants respectfully traverse these rejections, as set forth more fully below.

For at least the reasons set forth above, Miyoshi fails to teach or suggest each and every element of Applicants’ claims. As discussed above, Miyoshi does not teach or suggest sending the at least one input, received at the computer from an operator, to the control process virtually in parallel with the execution of the monitoring process.

Additionally, the Office Action concedes that “Miyoshi does not explicitly disclose receiving and sending input or output is executed by the computer under an operating system

comprising non real-time capabilities.” The Office Action attempts to cure the deficiencies of Miyoshi with Official Notice.

The PTO takes Official Notice that “non real-time systems are well known at the time the invention was made in the analogous art of data process.” (Office Action, 5). The Office Action suggests that “it would have been obvious to a person of ordinary skill in the art to have the operator distribute the input/output data not in real time.” (Office Action, 5). However, neither Miyoshi nor the Official Notice teach or suggest an operating system comprising non real-time capabilities that can send at least one input received from an operator virtually in parallel with the execution of the monitoring process. Because Miyoshi and the Official Notice, either alone or in combination, do not teach the limitations of Applicants’ claims, the Office Action has failed to establish the required *prima facie* case of unpatentability. See *In re Royka*, 490 F.2d 981, 985 (C.C.P.A., 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); See also MPEP §2143.03.

Therefore, Applicants respectfully request that the §103(a) rejections of claims 14, 15 and 22 be withdrawn.

**CONCLUSION**

Based on the foregoing remarks, Applicants respectfully request withdrawal of the rejections of claims and allowance of this application. In the event that a telephone conference would assist in the examination of this application, Applicants invite the Examiner to contact the undersigned at the number provided.

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 50-3732, Order No. 03869-105002US. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 50-3732, Order No. 03869-105002US.

Respectfully submitted,  
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